

U.S. Patent Application Serial No. 10/030,099
Response dated November 7, 2003
Reply to OA of August 7, 2003

REMARKS

Claims 1-12 are pending in this application. Claims 1, 6-8 and 11 have been amended herein.

Amendments to the claims have been made to address the objection to the claims and the rejection under 35 U.S.C. 112, second paragraph, as discussed below. In addition, a typographical error (“carbon10”) is corrected in claim 8.

No new matter has been added by this amendment.

Claim 11 is objected to because of the following informalities: “printedsurface” should have a space between the “d” and the “s”. (Office action paragraph no. 1)

The objection is overcome by the amendment to claim 11 correcting this typographical error.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office action paragraph no. 3)

The Examiner states that claim 2 recites that “ink-absorbing” and “ink-fixing” resins are different, while the specification describes these as the same component.

The rejection of claim 2 is respectfully traversed.

The Examiner is correct that claim 2 recites that the ink-absorbing resin on the first layer and the ink-fixing resin on the “other layer” are “different ingredients”, that is, chemically different

U.S. Patent Application Serial No. 10/030,099
Response dated November 7, 2003
Reply to OA of August 7, 2003

materials. This is supported by the specification on page 4, lines 19-24; page 9, line 25, to page 10, line 10; etc.

However, Applicants respectfully disagree with the Examiner that the specification describes the “ink-absorbing” and “ink-fixing” resins as being the same component. In particular, the specification on page 8, lines 13-23, clearly indicates the different functions of these resins and lists different possible materials for the two kinds of resins.

Reconsideration of the rejection is respectfully requested.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office action paragraph no. 4)

The rejection is overcome by the amendments to the claims.

In point (a), the Examiner states that there is insufficient antecedent basis for “the print film” in line 2 of claim 6. In point (b), the examiner states that the phrase “is formed at least on the print film of the ink” is confusing, and that this applies also “is formed at least on the print film of the oil-based ink” in claim 8. Claim 1 has been amended to recite “an ink layer containing fixed information” and Claim 6 has been amended to refer to “the ink layer” instead of “the print film of the ink used for printing.” Claim 8 has also been amended to replace “print film” with –ink layer–.

U.S. Patent Application Serial No. 10/030,099
Response dated November 7, 2003
Reply to OA of August 7, 2003

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent

No. 4,833,486 to Zerillo. (Office action paragraphs no. 6-7)

The rejection of claims 1 and 9 is respectfully traversed.

In the rejection, the Examiner cites Zerillo on column 3, lines 10-15, which state:

"As paper 32 or other printable material passes between the blanket cylinder 18 and the impression cylinder 24, the "reverse" image is printed on the paper, leaving a "positive" image of ink on the paper 32."

The Examiner also cites column 3, lines 14-30, which disclose the method of imaging the plate 30.

This method involves melting hydrophobic ink in an ink reservoir 50 and spraying minute ink droplets onto the plate 30.

However, Applicants submit that the passage on column 3, lines 10 to 15, of Zerillo, cited by the Examiner, merely discloses that printing ink is printed on a printing paper 32 by a lithographic printing method using a lithographic plate 30.

The thus obtained printed matter having an image of the printing ink formed on the printing paper 30 has **no layer equivalent to the ink receiving layer** set forth in Claims 1 and 9.

The passage on column 3, lines 14-30, of Zerillo, cited by the Examiner discloses a method for producing the lithographic plate 30. The lithographic plate 30 has an image of hydrophobic ink formed by means of an ink jet printer 44. If the hydrophobic ink image were considered to be equivalent to the ink receiving layer set forth in Claims 1 and 9, the plate 30 would have no layer equivalent to the ink layer containing fixed information set forth in claims 1 and 9. On the other hand, if the hydrophobic ink image were considered to be equivalent to the ink layer containing fixed

U.S. Patent Application Serial No. 10/030,099
Response dated November 7, 2003
Reply to OA of August 7, 2003

information set forth in claims 1 and 9, the plate 30 would have no layer equivalent to the ink receiving layer set forth in claims 1 and 9.

Therefore, Zerillo does not provide the elements of claims 1 and 9, and claims 1 and 9 are not anticipated by Zerillo.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,245,421 to Aurenty et al. in view of U.S. Patent No 6,541,567 to Riku et al. (Office action paragraphs no. 9-12)

Applicants note that the Examiner also addresses claim 10 in paragraph no. 9 of the Office action.

The rejection of claims 1-7 and 10 under 35 U.S.C. 103(a) is respectfully traversed and reconsideration of the rejection is respectfully requested.

Aurenty discloses a lithographic printing plate comprising (a) a substrate (such as paper) having hydrophilic, porous layer on at least one surface; and (b) an ink receptive, thermoplastic image layer adhered to the hydrophilic porous layer.

From the passage on page 4, lines 1 to 2, of the Office action, it appears that the Examiner considers the ink receptive, thermoplastic image layer to be equivalent to the ink layer containing fixed information set forth in claim 1.

If this were so, the printing plate would have **no layer equivalent to the ink receiving layer** set forth in claim 1. In the lithographic printing plate, the ink receptive image layer functions as an

U.S. Patent Application Serial No. 10/030,099
Response dated November 7, 2003
Reply to OA of August 7, 2003

image area to which printing ink is attached and the portion of the hydrophilic, porous layer on which the ink receptive image layer is not present functions as a non-image area onto which dampening water is attached and printing ink is not attached, when the lithographic printing is conducted. Therefore, in the lithographic plate, there is no layer equivalent to the ink receiving layer set forth in claim 1.

From the passage on page 4, lines 6-12, of the Office action, it appears that the Examiner considers both the hydrophilic, porous layer and the ink receptive, thermoplastic image layer to be equivalent to the ink receiving layer set forth in claim 1.

If this were so, the lithographic printing plate would have **no layer equivalent to the ink layer containing fixed information** set forth in claim 1. As described above, in the lithographic printing plate, the portion of the hydrophilic, porous layer on which the ink receptive image layer does not exist functions as a non-image area onto which dampening water is attached and printing ink is not attached, when the lithographic printing is conducted. Therefore, in the lithographic printing plate, there is no room for a layer equivalent to the ink layer containing fixed information set forth in claim 1 which ruins the function of non-image area.

Riku discloses a coating composition for forming an ink-receiving layer. This ink-receiving layer can be on paper. However, Riku does not disclose forming an ink receiving layer as well as an ink layer containing fixed information on paper.

U.S. Patent Application Serial No. 10/030,099
Response dated November 7, 2003
Reply to OA of August 7, 2003

Thus, the combination of Riku and Aurenty fails to provide the elements recited in the claim 1, and claims 1 to 7 and 10 are novel and non-obvious over Aurenty et al. (U.S. Patent No. 6,245,421) and Riku et al. (U.S. Patent No 6,541,567), taken separately or in combination.

Regarding claim 11 and the wet condition the printed surface is in, this is inherent in the product. (Office action paragraph no. 13)

The Examiner apparently extends the above rejection of claims 1-7 under 35 U.S.C. 103(a) to claim 11. The rejection of claim 11 is respectfully traversed for the same reasons given above for claims 1-7.

Moreover, Applicants respectfully disagree with the Examiner's position that the wet condition is inherent in product-by-process claim 11. In the process in claim 11, the receiving layer is formed immediately after printing the fixed information. The alternative would be to let the oil-based ink dry before formation of the ink-receiving layer. Claim 11 recites a proper additional limitation over claim 7.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,245,421 to Aurenty et al. in view of U.S. Patent No. 6,541,567 to Riku et al. and further in view of U.S. Patent No. 6,509,085 to Kennedy. (Office action paragraphs no. 14-15)

The rejection of claim 12 is respectfully traversed and reconsideration of the rejection is respectfully requested.

U.S. Patent Application Serial No. 10/030,099
Response dated November 7, 2003
Reply to OA of August 7, 2003

Applicants have argued above that no *prima facie* case of obviousness can be made for claim 1 using Riku and Aurenty, because these references fail to disclose or suggest the receiving layer and the ink layer containing fixed information in claim 1. Kennedy is cited for teaching a coater having an anilox roll and a rubber roll, but Applicants submit that Kennedy does not disclose or suggest the printed matter as recited in claim 1. Kennedy therefore does not cure the deficiency in the *prima facie* case, and claim 12 is novel and non-obvious over Riku et al., Aurenty et al. and Kennedy, taken separately or in combination.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,245,421 to Aurenty et al. in view of U.S. Patent No. 6,541,567 to Riku et al. and further in view of U.S. Patent No. 5,367,026 to Okude et al. (Office action paragraphs no. 16-17)

The rejection of claim 8 is respectfully traversed and reconsideration of the rejection is respectfully requested.

The Examiner cites Okude et al. for teaching the resin composition of claim 8. Okude et al. generally teaches a thermosetting resin composition which is suitable for top-coating and coal-coating paint.

Applicants have argued above that no *prima facie* case of obviousness can be made for claim 1 using Riku and Aurenty, because these references fail to disclose or suggest the receiving layer and the ink layer containing fixed information in claim 1. Okude et al. does not address printed matter

U.S. Patent Application Serial No. 10/030,099
Response dated November 7, 2003
Reply to OA of August 7, 2003

as recited in claim 1, and therefore does not cure the deficiency in the *prima facie* case of obviousness.

In addition, Applicants note that the Examiner refers to the disclosure of Okude et al. in column 6, line 65, that the composition may be coated on wood, metal, glass, fabric, plastics, plastic foam and the like. This disclosure does not appear to suggest coating on paper in association with oil-based ink printing. Moreover, the Examiner has not clearly stated which component in Okude et al. is supposed to correspond to the film forming improving agent in claim 8.

Applicants therefore submit that claim 8 is non-obvious over Aurenty et al., Riku et al. and Okude et al., taken separately or in combination.

U.S. Patent Application Serial No. **10/030,099**
Response dated November 7, 2003
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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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